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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/751,000	12/29/2000	Sadao Hirae	P/1596-51	9450

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NEW YORK, NY 100368403

EXAMINER

KORNAKOV, MICHAEL

ART UNIT	PAPER NUMBER
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1746

DATE MAILED: 02/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/751,000

Applicant(s)

HIRAE ET AL.

Examiner

Mikhail Kornakov

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 25-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 25-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/25/2005 has been entered.
2. Claims 25-28 are pending. Claim 25 has been amended to include the functional limitation of a controller "...being structured to rotate... and to supply and Being structured to control..."

Interpretation of Claims

3. Limitations of a controller being structured to perform certain functions as appears in the instantly amended claim 25 are interpreted in light of the instant specification that on page 15 states "The electric motor 5, drive mechanism 13, control valve 10 19, ozone water feeder 21, ultrasonic vibration power source 23, ozoneless UV lamp power source 37 noted above are controlled en bloc by the controller 17. This is the only place in the specification where Applicants elaborate on the functions of the controller. As for the structural units of the controller per se, those are absent in Applicants' specification. Flow diagram on Fig.2 also shows the connection of the controller to the above mentioned units of the claimed apparatus.

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4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 25, 26 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over JP63-15710.

JP'710 teaches an article treating apparatus comprising supporting means, rotatable by a motor; a cleaning liquid ejecting device for supplying a cleaning liquid to the upper surface of the article; an ultraviolet radiating device, including a device body (reads on "a reflector, as instantly claimed) and a lamp, the said device positioned above the support means; a controller, which controls functioning of the structural elements of the apparatus, particularly liquid ejecting device, rotatable supporting means and the ultraviolet radiating device (Abstract; Fig. 1; pages 57-59). The indicated wavelength of UV light is 254 nm (page 58, col.5; page 59, col. 9), which is within the instantly claimed range. The cleaning liquid ejecting device of JP'710 is fully capable of supplying a cleaning solution having ozone dissolved in deionized water. The controller of the apparatus of JP'710 is identically to the instantly claimed one connected to the rotatable support means, to the ozone water supply to the UV lamp power supply, and is, therefore, fully capable of controlling the operation of UV radiating device to emit UV light to the substrate being covered with cleaning liquid, and perform all other functions as claimed by Applicants.

Applicants' attention is drawn to the fact that apparatus claims must be structurally distinguishable from the prior art in terms of structure not function. *In re Danley*, 120

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USPQ 528, 531 (CCPA 1959); Hewlett-Packard Co. V. Baush and Lomb, Inc., 15

USPQ2nd 1525, 1528 (Fed. Cir. 1990).

Thus, all the limitations of the instant claims in terms of structure are met by JP'710.

6. Claims 27 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP63-15710 in view of Yeol et al (U.S. 5,983,909).

JP'710 remains silent about base adding means for adding a base to the cleaning liquid. However, auxiliary supply means for adding basic or other cleaning enhancing components are conventionally utilized in the art. Thus, Yeol teaches that aqueous alkaline cleaning solutions are conventionally employed in the art (col.1, lines 45-50). Therefore, one skilled in the art motivated by Yeol would have found obvious to provide base adding means in order to supply basic components into the cleaning solution, thus enhancing cleaning of articles in the treatment apparatus of JP'710.

Response to Arguments

7. Applicant's arguments filed 12/25/2005 have been fully considered but they are not persuasive. The crux of Applicants' arguments with regard to JP' 710 reference appears to hinge on Ex Parte Pilkington, 137 USPQ 229, 230 (POBA, 1962), that permits the apparatus to be claimed not only by its structural limitations, but by its functional limitations. IN response to this, the Examiner's position, is that if such functional limitations do distinguish from the prior art, then the apparatus described by

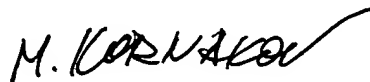
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the functional limitations, may be patentable. In the instant case the controller of JP'710 performs the same functions as the controller of the instant claims (please, compare the statement on page 15 of the Applicants' specification and Fig. 2 of Applicants with the Fig.1 of JP'710). Therefore, lacking structural limitations of the instantly claimed controller, the controller of the instant claims is fully met by that of JP'710.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mikhail Kornakov whose telephone number is (571) 272-1303. The examiner can normally be reached on 9:00 - 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Barr can be reached on (571) 271-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Mikhail Kornakov
Primary Examiner
Art Unit 1746

February 20, 2006